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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/821,174	03/29/2001	Keiichi Furukawa	15162/03420	4027

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EXAMINER

HARVEY, JAMES R

ART UNIT PAPER NUMBER

2833

DATE MAILED: 12/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/821,174

Applicant(s)

FURUKAWA ET AL.

Examiner

James R. Harvey

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 October 2002 and 15 October 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-86 is/are pending in the application.
- 4a) Of the above claim(s) 3-15 and 17-86 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Preliminary Amendment

- The preliminary amendment filed 10-19-02 (certificate of mailing date 10-8-02) adds new dependent claims 83-86. However, the statement appearing on page 18, lines 9-11 concerning “..increasing the number of independent claims by 4 from 82 to 86..” and “...does not increase the total number of claims...” appears to be a typographical error and should be corrected by changing independent claims to claims and total number of claims to total number of independent claims.
- Correction or explanation is required.

Information Disclosure Statement

- The Information Disclosure statement(s) and related documents that were filed on 3-29-01 have been considered.

Election/Restrictions

- Applicant's election with traverse of (claims 1, 2, 16 (Group I)) in Paper No. 8 is acknowledged. The traversal is on the ground(s) that no serious burden would be required to examine the 82 claims that were pending in the originally filed application. Applicant also submits an alternative argument that the search and examination of claim 1-19 would be less of a burden than the 82 claims that were pending in the originally filed application.
- These arguments are not found persuasive because the MPEP requires that the examiner “...must examine...” the application on the merits if two conditions are met; the first condition is “...the search...can be made without a serious burden...”. The second

condition is "...examination of the entire application can be made without a serious burden...".

A key element concerning the "...examination of the entire application..." and of these conditions is if the species are patentably distinct. If the species are not patentably distinct, then the examination may not be a burden. However, if the species are patentably distinct, then the examination is seen to be a burden because of the intricacies associated with the patentably distinct species.

In the previous office action, applicant was advised to "...submit evidence or identify such evidence now of record..." if the species were not patentably distinct in order to make the record clear concerning the examination and its associated burden. However, applicant did not make any attempts to address if the species were or were not patentably distinct. The examination of the distinct species is therefore deemed to be a serious burden and meets the second condition of the restriction section of the MPEP.

- The preliminary amendment filed 10-19-02 (certificate of mailing date 10-8-02) adds new dependent claims 83-86, but fails to adhere to the restriction requirement "...and a listing of all claims readable thereon, including any claims subsequently added...". Accordingly, claims 83-86 are withdrawn from consideration as being directed to a non-elected invention.
- The requirement is still deemed proper and is therefore made FINAL

Priority

- Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim R jections - 35 USC § 102

- The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

- Claim(s) 1, 2, and 16 are rejected under 35 U.S.C. 102(a) as being anticipated by Shida et al. (JP Publication number 11-249152).

-- In reference to claim 1, Shida shows the method of opposing (English translation page 6, lines 19-22) a first panel element 2 and a second panel element 1, each having at least one display layer (English translation page 6, lines 8-11), with positioning the first and second panel elements relatively to each other (panel-opposing step); and

progressively adhering (figure 2), after the panel-opposing step, the first and second panel elements from a starting position (below wheel 7) with an adhesive material (panel-adhering step)(“epoxy resin”, English translation page 6, lines 12-14).

-- In reference to claim 2, Shida shows the method of the panel-opposing step includes the step of positioning the first panel element and causing a first stage English translation page 6, line 20

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(temporarily fixing) to hold the first panel element and the step of positioning the second panel element and causing a second stage (rubber plate 3) to hold the second panel element.

-- In reference to claim 16, shows the starting position (figure 2) is located on ends of the first and second panel elements.

Conclusion

- The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Carre et al., Takahara et al., and Thatcher show the state of the art with respect to applicant's broadly claimed invention.
- Any inquiry concerning this communication or earlier communications from the examiner should be directed to James R. Harvey whose telephone number is 703-305-0958. The examiner can normally be reached on 8:00 A.M. To 5:00 P.M.
- If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula A. Bradley can be reached on 703-308-2319. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7724 for regular communications and 703-308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0952.

James R. Harvey, Examiner

jrh

December 10, 2002


P. AUSTIN BRADLEY
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